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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,913	02/27/2002	James J. Jakubowski	43231C	3329

109 7590 06/01/2004

THE DOW CHEMICAL COMPANY
INTELLECTUAL PROPERTY SECTION
P. O. BOX 1967
MIDLAND, MI 48641-1967

EXAMINER

NILAND, PATRICK DENNIS

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,913

Applicant(s)

JAKUBOWSKI ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9 and 13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7,9 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7, 9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4092286 Noll et al..

Noll discloses the instantly claimed composition at the abstract; column 2, lines 46-68; column 4, lines 52-58; column 7, lines 65-68; column 8, lines 41-68; column 9, lines 1-15, of which the amine/water mixture of the paragraph bridging columns 8-9 will necessarily give some reaction of water with the NCO prepolymer, which falls within the scope of the instantly claimed chain extension with water, column 11, lines 8-46; and column 13, lines 25-27 and 49-50 for the instantly claimed solids content. The choice of anionic emulsifiers from the ionic emulsifiers of column 11, lines 43-45 is not so great as to remove Noll as an anticipating reference as they are the most commonly used emulsifiers from a group of anionic, cationic, and rarely used zwitterionic emulsifiers. See *In re Arkley*, 455 F 2d 586, 172 USPQ 524 (CCPA 1972) and *In re Petering*, 301 F 2d 676, 133 USPQ 275 (CCPA 1962). The lower weight fraction (note the definition of

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average molecular weight in polymer chemistry) of the polyurethane of the patentee falls within the scope of the instantly claimed "alkali metal soap of a modified resin".

4. Claims 7, 9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4092286 Noll et al..

Noll discloses the instantly claimed composition at the abstract; column 2, lines 46-68; column 4, lines 52-58; column 7, lines 65-68; column 8, lines 41-68; column 9, lines 1-15, of which the amine/water mixture of the paragraph bridging columns 8-9 will necessarily give some reaction of water with the NCO prepolymer, which falls within the scope of the instantly claimed chain extension with water, column 11, lines 8-46; and column 13, lines 25-27 and 49-50 for the instantly claimed solids content. The choice of anionic emulsifiers from the ionic emulsifiers of column 11, lines 43-45 is not so great as to remove Noll as an anticipating reference as they are the most commonly used emulsifiers from a group of anionic, cationic, and rarely used zwitterionic emulsifiers. See *In re Arkley*, 455 F 2d 586, 172 USPQ 524 (CCPA 1972) and *In re Petering*, 301 F 2d 676, 133 USPQ 275 (CCPA 1962). The lower weight fraction (note the definition of average molecular weight in polymer chemistry) of the polyurethane of the patentee falls within the scope of the instantly claimed "alkali metal soap of a modified resin".

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the dispersion forming ingredients and amounts of Noll which fall within the scope of the instant claims and which have the instantly claimed parameters because they are encompassed by Noll and would have been expected to give the dispersion properties described by Noll. It would have been obvious to one of

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ordinary skill in the art at the time of the instant invention to use the instantly claimed emulsifiers because they are shown by Blake to be useful in polyurethane emulsions (abstract and column 7, lines 21-31) and these fall within the scope of ionic emulsifiers of Noll.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (571) 272-1121. The examiner can normally be reached on Monday through Thursday from 10 a.m. to 5 p.m.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be

reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

May 31, 2004


Patrick Niland
Primary Examiner
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